



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Appl. No. : 09/717,894
Applicant : Buettgen et al.
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TC/A.U. : 1651
Examiner : Irene Marx

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Handwritten signature: C. 1651 Buettgen

CERTIFICATE OF MAILING

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TRANSMITTAL OF REPLY BRIEF

Sir:

On August 26, 2003, an Examiner's Answer to Appellant's brief in support of the appeal against the final rejection of the pending claims in the above-captioned application was mailed.

What follows in the remainder of this paper is Appellant's response, as permitted under 37 C.F.R. 1.193(b), to the Examiner's new points of argument.

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REPLY BRIEF

Perceived New Point of Argument by the Examiner. "Appellant's argument that Gatfield does not teach the 'direct esterification of free fatty acids with lower alkanols such as ethanol in the presence of an enzyme' is confusing, since it is apparent from Lepper *et al.* that vegetable oils and tallow contain free fatty acids, which would be directly esterified. The claims as written fail to exclude transesterification, since they are drafted in terms of the open language 'comprising'." (pages 5-6, paragraph 11, of the Answer).

Rebuttal: The claimed invention is **NOT** directed to the esterification of **trace amounts** of free fatty acids in an oil. Rather, the claimed invention is directed to the deacidification of fats/oils. While the claimed invention does not expressly and literally exclude transesterification, it is directed to **a process for deacidifying fats/oils**. The issue regarding the failure of the claims to exclude transesterification based on the use of the term "comprising" is completely **irrelevant** to a determination of whether the claimed invention is rendered *prima facie* obvious by the references relied upon by the Examiner. The same is true with regards to the trace amounts of free fatty acids which may be esterified using Gatfield's process, i.e., this argument is also completely **irrelevant** to a determination of whether the claimed invention is rendered *prima facie* obvious by the references relied upon by the Examiner. Appellant continues to fail to understand why the Examiner cannot comprehend the difference between a deacidification (esterification) process and a transesterification process.

Perceived New Point of Argument by the Examiner. "[T]his step is followed by a transesterification step which would have reasonably been expected to lower the acid value even further...In addition, touted results are obtained in the instant specification only in Examples 1 and 2. In these Examples a specific enzyme, the lipase from *Candida antarctica*, NOVOZYM® 435, is used to bioconvert a specific substrate, crude coconut oil

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with an acid value of 8.2, under specific process conditions. **This is not the invention claimed.**" (emphasis added)(page 6, paragraph 11, of the Answer).

Rebuttal: Once again, the claimed invention is directed to a process for deacidifying fats/oils by reacting the triglycerides with a lower alcohol and lipase to form a pre-esterification process, optionally removing water and unreacted alcohol from said product, followed by further reacting said product with more lower alcohol. This is **precisely** what is disclosed in Examples 1 and 2 of the specification. Why this is unclear to the Examiner remains a mystery to Appellant.

Perceived New Point of Argument by the Examiner. "[T]he process described at Brief, paragraph 2) is the same esterification/transesterification process as claimed, albeit using chemical catalysts." (page 6, paragraph 11, of the Answer).

Rebuttal: The claimed invention **IS NOT** directed to a transesterification process. Moreover, this statement serves as yet another example of the Examiner's mistaken belief that esterification is equivalent to transesterification.

Respectfully submitted,



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